

## REMARKS

Claims 1-21 are currently pending in the application. Claim 1 has been amended. Applicants respectfully assert that no new matter has been added and request reconsideration of the claims currently pending in the application.

On page 2 of the Office Action, claim 1 is rejected under 35 U.S.C. § 112 second paragraph for being indefinite. The Applicants respectfully traverse this rejection, but have amended the application to overcome the objections. Claim 1 has been amended at line 5 to recite "a handle" instead of "the handle", as suggested by the Examiner. Applicants respectfully assert that all claims comply with 35 U.S.C. §112 and request that the rejection be withdrawn.

On page 2 of the Office Action, claims 1-8 and 10-20 are rejected under 35 U.S.C. §102 (b) as being anticipated by Garrison, et al. (U.S. Patent Number 5,972,030). Applicants respectfully traverse the rejections. However, the Applicants have amended claim 1 to more particularly point out and distinctly claim the present invention. The Applicants respectfully submit that claim 1 distinguishes over the prior art, and that claim 1 and all claims dependent on claim 1 are in condition for allowance.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain

a rejection based on 35 U.S.C. §102. Applicants respectfully submit that Garrison et al. do not teach every element of claim 1, and therefore fail to anticipate claim 1.

Claim 1 recites that the release mechanism 16 is integrally coupled to the handle coupling 14. Handle coupling 14 is mounted with holder body 12. The release mechanism is entirely independent of the handle, and the handle is not needed to form the complete release mechanism, or for the release mechanism to function.

Garrison et al. do not teach a release mechanism 26 that is integral with the handle coupling 80. Rather, the handle coupling 80 is mounted on the holder body 70, and the release mechanism 26 is part of the handle 10. See Col. 14, lines 6-8; Figures 1-4, 6-9, 15-20, 23-24, and 30-34.

Moreover, the section of Garrison et al. cited by the office action (Col. 18, line 60 through Col. 19, line 2) does not alter this analysis. That section specifically states that the disclosed configurations for the holder coupling 26 and the handle coupling 80 should not be taken to limit the range of possible interconnections between holder 70 **and delivery handle 10**. This section does not disclose a release mechanism that is integrally coupled to the handle coupling.

Claims 2-8 and 10-16, which are dependent from independent claim 1, were also rejected under 35 U.S.C. §102(b) as being unpatentable over Garrison et al. While Applicants do not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with independent claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish

these claims from the cited reference. Therefore, it is respectfully submitted that dependent claims 2-8 and 10-16 are also in condition for allowance.

Regarding claims 17-20, the office action states on page 4 that Garrison et al. disclose a handle (10) comprising an elongate shaft (20), a gripping portion (28) that includes ribs, and a tip (26) coupled to the other end of the elongate shaft. Applicants respectfully submit that Garrison et al. do not disclose all the elements of Applicants' invention as recited in claim 17. First, Applicants respectfully submit that neither column 14 nor Figures 1-4 disclose ribs on the handle. At most, faces are shown on the handle 28, and faces are not the same as ribs. Second, the Applicants respectfully submit that the tip 26 of Garrison et al. comprises a mechanism to hold leaf spring 38, which comprises catch 44. The leaf spring 38 and catch 44 serve to retain the prosthesis holder on coupling 26. Claim 17 on the other hand, recites that the tip includes a protuberance and an abutting surface, which does not serve to retain a prosthesis holder, but rather serves to prevent the handle from penetrating too deeply into the prosthesis holder. Consequently, claim 17 recites structure that is not disclosed in Garrison et al., and hence claim 17 is not anticipated by Garrison et al. Since claims 18 - 20 are dependent on claim 17, and thereby contain all the limitations of claim 17, claims 18 - 20 are also not anticipated by Garrison et al.

For at least the foregoing reasons, Applicants respectfully request withdrawal of the rejection of claims 1-8, and 10-20 under 35 U.S.C. §102. (b) as being anticipated by Garrison, et al.

On page 5 of the Office Action, claims 9 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrison, et al. in view of Rhee, et al. (U.S. Patent Number 6,019,739). Applicants respectfully traverse the rejections.

Three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142. Applicants respectfully traverse the rejection since the prior art fails to disclose all the claim limitations.

As discussed above with respect to claim 1, Garrison et al. do not teach a release mechanism 26 that is integral with the handle coupling 80. With respect to claim 17, Garrison does not set forth ribs, or a tip including a protuberance or abutting surface. Rhee fails to remedy the deficiencies of Garrison et al., and thus, all the claim limitations are not disclosed.

Claims 9 and 21 are dependent on claims 1 and 17, respectively. While Applicants do not acquiesce with the particular rejections to claims 9 and 21, it is believed that these rejections are moot in view of the remarks made in connection with independent claims 1 and 17 above. Claims 9 and 21 includes all of the limitations of claims 1 and 17 and any intervening claims, and recite additional features which further distinguish them from the cited references. Therefore, dependent claims 9 and 21 are in condition for allowance.

Applicants respectfully request withdrawal of the rejection of claims 9 and 21 under 35 U.S.C. § 103(a) as being obvious in light of Garrison, et al. in view of Rhee, et al.

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicants respectfully request favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicants' attorney of record, Hallie A. Finucane at (952) 253-4134.

Respectfully submitted,

Altera Law Group, LLC  
Customer No. 22865

Date: December 23, 2003

By:



Hallie A. Finucane  
Reg. No. 33,172  
HAF/mar